

## **REMARKS**

Reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested. Claims 1-44 were presented for initial examination in the present application. Claims 7 and 27 are cancelled, without prejudice, and independent claims 1 and 21 are hereby amended. Basis for the amendments may be found in the specification, e.g., at page 7, lines 6-8 and lines 19-20.

### **1. Response to Claim Rejections Under 35 U.S.C. 102**

In the outstanding Office Action, claims 1-38, 40-41 and 43-44 were rejected under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 5,528,261 to Holt et al. ("Holt"). In that regard, the Examiner stated as follows:

As per independent claim 1, Holt discloses a process for producing an electronic color information file for color communication, wherein the file includes at least one data set describing the color impression of at least one color sample comprising making available one data set (Fig. 6; col. 4-5, II. 66-2), storing the data set in a preselected data format in the color information file (col. 5, II. 21-25), all the information data associated with the color sample (col. 5, II. 21-25) and one of identifying, characterizing, and supplementing the one color sample (col. 5, II. 24-27) are stored as information containing data objects (col. 5, II. 40-45) in an open, expandable, hierarchically organized object structure in the color file (abstract).

As per dependent claims 2 and 22, Holt discloses each data object is labeled with a characterizing type description selected from a group of predefined type descriptions (col. 6, II. 33-38), the type description provides details on the structure and content of the data object (col. 6, II. 33-48) and the data type description of the data object is stored in the color information file in defined relation to the information data of the data object (col. 6, II. 33-50).

As per dependent claims 3 and 23, Holt discloses one data object includes one hierarchically subordinate data object (col. 6, II. 33-45), each subordinate data object is labeled with a characterizing type description (col. 9, II. 50-55) selected from a predefined group of type descriptions (col. 6, II. 33-38), the type description provides details on the structure and content of the data object (col. 6, II. 33-48) and the data type description of the data object is stored in the color information file in defined relation to the information data of the data object (col. 6, II. 33-50).

As per dependent claims 4 and 24, Holt discloses a name is associated with one of the data object of the uppermost level of the hierarchy (col. 6, II. 33-36) and the data objects respectively subordinate to a data object (col. 7, II. 45-55), which name defines the respective data objects and is stored in the color information file in defined relation to the respective data objects (col. 6, II. 33-55).

As per dependent claims 5 and 25, Holt discloses an explanatory description is associated with one of the data object of the uppermost level of the hierarchy (col. 6, II. 33-36; col. 9, II. 50-60) and the data objects respectively subordinate to a data object (col. 7, II. 45-55), which explanatory description defines the respective data objects and is stored in the color information file in defined relation to the respective data objects (col. 6, II. 33-55; col. 9, II. 50-60).

As per dependent claims 6, 26 and 41, Holt discloses at least one data object includes a subordinate data object, which represents a connection pointer to another data object within or outside the color information file (col. 6, II. 1-15).

As per dependent claims 7 and 27, Holt discloses all data objects are stored in at least one text format in the color information file (col. 5, II. 65-67; col. 6, II. 15-20).

As per dependent claims 8 and 28, Holt discloses at least one data object includes a binary data object as information data, wherein this binary data object is stored in the color information file as symbols in MIME-compatible format (i.e. text representation) (col. 29-30).

As per dependent claims 9 and 29, Holt discloses the hierarchically organized object structure of the data objects is built on the basis of a page description (abstract).

As per dependent claims 10 and 30, Holt discloses the step of storing the information data which are associated with one color sample and one of identify, characterize, and complement the color sample is carried out by arbitrarily selecting from a predefined group of data object types (col. 5, II. 15-18; col. 6, II. 20-40).

As per dependent claim 11, Holt discloses the predefined group of data object types can be expanded with additional data object types (col. 14, II. 40-65).

As per dependent claims 12 and 31, Holt discloses the predefined group of data object types includes at least data objects for spectral and calorimetric data (col. 11, II. 40-60; Fig. 7).

As per dependent claims 13 and 32, Holt discloses the predefined group of data object types additionally includes data objects for further information data relevant for the visual impression of the color (col. 10, II. 30-65).

As per dependent claims 14 and 33, Holt discloses the predefined group of data object types additionally includes data objects for ICC profiles (col. 10, II. 30-65), measurement conditions (col. 14, II. 25-40), light source data (col. 11, II. 40-60) and device profiles (col. 11, II. 65-67).

As per dependent claims 15 and 34, the predefined group of data object types additionally includes data objects for image data (col. 2, II. 15-30).

As per dependent claim 16, Holt discloses the predefined group of data object types additionally includes at least one of data objects for image data (col. 12, II. 32-35) and substrate describing data, wherein the image data preferably represent structure information such as surface condition (i.e. surface brightness as determined by spectral energy distribution) or graininess of the at least one color sample to be communicated (Fig. 7; col. 11, II. 40-61)

As per dependent claim 17, Holt discloses the predefined group of data object types additionally includes data objects for supplementary data (col. 9, II. 50-60) representable in text format (col. 7, II. 45-55):

As per dependent claims 18 and 36, Holt discloses any combination of emission, remission and transmission spectra, and calorimetric data (i.e. dominant wavelength used to determine surface luminance) are stored in the color information file (col. 11, II. 40-61; Fig. 7).

As per dependent claims 19 and 37, Holt discloses emission spectra and remission spectra of the one color sample are stored in the color information file (col. 11, II. 40-60), such that the illumination light source can be taken into consideration by way of a color model for the visual representation of the one color sample on a screen (Fig. 4; col. 5, II. 55-65).

As per dependent claims 20 and 38, Holt discloses an input profile and several output profiles assigned to a color sample and stored in the color information file (Fig. 1), and the input profile is used to recalculate a color sample from a device dependent color space into a device independent color space (col. 12-13, II. 64-6), and the output profiles are used to recalculate the color location of the color sample from the device independent color space into a selected device dependent color space (col. 11, II. 5-15) and to display the color location therein (Fig. 8).

As per independent claim 21, Holt discloses a process for communicating information relevant for visual color impression of a color sample comprising storing the information represented by the one of measured data and manually produced value data at a transmitter end in a color information file (col. 5, II. 40-45), and transferring the color information file to a receiver by way of a communication medium (col. 4-5, II. 64-2; Fig. 1), and displayed in visual form at the receiver end (col. 1, II. 20-25), all the information data associated with the color sample (col. 5, II. 20-25) and at least one of identifying, characterizing and supplementing the color sample (col. 5, II. 24-27), being stored as information

containing data objects (col. 5, II. 40-45) in an open, expandable, hierarchically organized object structure in the color file (abstract).

As per dependent claim 35, Holt discloses the predefined group of data object types additionally includes at least one of data objects for image data and substrate describing data, whereby the image data preferably represent structure information of the at least one color sample to be communicated (col. 12, II. 32-35).

As per dependent claims 40 and 43, Holt discloses the predefined group of data object types includes device dependent color data (col. 8, II. 1-5).

As per dependent claim 44, Holt discloses structure information includes at least one of surface condition or graininess (col. 11, II. 40-61; Fig. 7).

The Applicants hereby traverse the Examiner's rejection and respectfully submit that claims 1-38, 40-41 and 43-44 are patentably distinguishable over Holt. Concerning 35 U.S.C. § 102 rejections, as the Examiner knows, MPEP §2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

As noted above, independent claims 1 and 21 of the present application (the sole independent claims) have been amended herein. As amended, independent claims 1 and 21 recite, inter alia:

- storing the at least one data set in a preselected data format in the color information file in a text format, and
- storing the at least one data set such that all the information data associated with the at least one color sample and at least one of identifying, characterizing, and supplementing the at least one color sample are stored as information data in a text format containing data objects that are in an open, expandable, hierarchically organized object structure in the color information file.

Applicants respectfully submit that Holt does not disclose each and every element of independent claims 1 and 21, as amended, either explicitly or inherently. Moreover, each of dependent claims 2-6 and 8-20 depend directly or indirectly from independent claim 1, while each of dependent claims 22-26, 28-38, 40-41 and 43-44 depend directly or indirectly from independent claim 21. Thus, for at least the reasons that independent claims 1 and 21 are not anticipated by Holt, applicants submit that Holt fails to disclose each and every element of applicants' pending dependent claims, either explicitly or inherently.

The Holt reference describes an operating system software architecture, implemented in an object-oriented design, for supporting color processing. Such object-oriented operating systems include an integrated color module having several interface levels, an input interface software module for inputting color data from peripheral devices to the integrated color module, and an output software interface module for outputting color data processed by the integrated color module to peripheral devices. According to the object-oriented architecture, data representing colors is abstracted and encapsulated. The interfaces to individual objects may remain constant, while the objects themselves are abstract and independent. Such interfaces present an outside view of a class or object, which emphasizes the abstraction of the class or object, while hiding its structure and behavior.

Applicants' innovative approach to processing color-related information moves in a different direction relative to the teachings of Holt. Beyond the numeric or quantitative values that the Holt system is designed to process and communicate between a processor and peripheral components, applicants' claimed process stores at least one data set in a preselected data format in a color information file in a text format. Utilization of a text format is contrary to the teachings of the Holt system design, but offers users increased flexibility and functionality relative to the teachings of the Holt patent. Thus, applicants' independent claim 1 (as amended) is directed to:

Process for producing an electronic color information file in a text format for color communication, wherein the file includes at least one data set describing the color impression of at least one color sample, comprising the steps of:  
making available the at least one data set in a processor; and  
storing the at least one data set in a preselected data format in the color information file in a text format, such that all the information data associated with the at least one color sample and at least one of identifying, characterizing, and supplementing the at least one color sample are stored as information data in a text format containing data objects in an open, expandable, hierarchically organized object structure in the color information file. (emphasis added).

Independent claim 21 of the present application (as amended) is directed to:

Communication process for communicating information relevant for visual color impression of a color sample set including at least one color sample, comprising the steps of:  
storing the information represented by at least one of measured data and manually produced value data at a transmitter end in a color information file in a text format; and  
transferring the color information file to a receiver by way of a communication medium and at the receiver end again displayed in visual form, wherein all the information data associated with the at least one color sample and at least one of identifying, characterizing, and supplementing the at least one color sample, being stored as information data in a text format containing data objects in an open, expandable, hierarchically organized object structure in the color information file. (emphasis added).

Thus, the claims of the present applications require that color information data is stored in a file in a text format. The presently claimed process advantageously electronically stores and communicates **both** color data **and** the parameters associated therewith, through its utilization of text format data storage. Indeed, applicants' claimed process facilitates data storage that extends beyond the numeric values associated with a color sample, i.e., through the use of text format data storage, and thereby facilitates advantageous data exchange. Further, according to the present disclosure, colors may be specified in a variety of ways and those specifications may be made available to many possible software applications, so that users can select which aspect of the color definition they wish to use in their applications (see page 5, 2nd paragraph). Applicants' claimed process thus greatly enhances the power and flexibility associated with color systems, both in terms of storage and data exchange/communication.

Applicants note that the color hierarchical structure of Holt, which is shown for example in Fig. 5, is determined by a program that may be embodied in a text format (col. 6, lines 15-20). However, Holt neither discloses nor suggests storing or transmitting data related to a color sample in a text format. As is apparent from the Holt specification (e.g., col. 5, line 66 to col. 6, line 33), the color-related information processed by the Holt system is manipulated according to object-oriented principles, but the color information itself consists of, and is limited to, numeric values, not text. Holt neither discloses nor suggests converting these numeric values into text, and altogether fails to recognize or appreciate the significant advantages that are achieved according to applicants' claimed process through the storage/communication of relevant data in a text format. Thus, applicants respectfully submit that independent claims 1 and 21 of the present application (as amended) are not anticipated by Holt and an official action acknowledging the same is respectfully requested.

Claims 2-6, 8-20, 22-38, 40-41 and 43-44 depend either directly or indirectly from independent claim 1 or independent claim 21, and each claim thus incorporates all of the limitations of either independent claim 1 or independent claim 21. Therefore, applicants submit that claims 2-6, 8-20, 22-38, 40-41 and 43-44 are not anticipated by Holt at least for the reasons set forth above with respect to amended claims 1 and 21, and an official action acknowledging the same is respectfully requested.

**2. Response to Claim Rejections Under 35 U.S.C. 103(a)**

In the outstanding Office Action, the Examiner rejected dependent claims 39 and 42 under 35 U.S.C. 103(a) as being unpatentable over Holt as applied to claims 1 and 21, and further in view of U.S. Patent No. 6,515,690 to Back et al. ("Back"). In that regard, the Examiner stated as follows:

As per dependent claims 39 and 42, Holt fails to disclose the hierarchically organized object structure of the data objects is built on the basis of Extensible Markup Language, which Back discloses (col. 6, II. 38-47; col. 7, II. 40-45).

Holt teaches a computer system communicating with peripheral devices in an object-oriented architecture, which receives input color data, accesses hierarchical files and transmits corresponding output data. Back teaches an object oriented system using XML (Extensible Markup Language) files to output desired display attributes stored in the files that correspond to system input. It would have been obvious to one of skill in the art to include Back's object structure built on the basis of Extensible Markup Language with the disclosure of Holt to improve indexing of a variety of stored data.

In establishing obviousness under section 103, the Examiner carries the burden of presenting a *prima facie* case, *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and must show that the reference(s) relied on teach or suggest all of the limitations of the claims. *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 U.S.P.Q.2d 1237 (Fed. Cir. 1995), *cert. denied*, 117 S.Ct. 80 (1996).

Applicants respectfully submit that when determining the differences between the prior art and the claims at issue, it is essential to view the claims at issue as "the invention as a whole." 35 U.S.C. § 103. It is legally improper to focus on the obviousness of substitutions and differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention *as a whole* relative to that prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 U.S.P.Q. 81, 93 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

Furthermore, according to MPEP §2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations . . .

Thus, while obviousness may be found by combining references, absent a suggestion to combine the references such combination is inappropriate. *Texas Instruments Inc.*



*v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 U.S.P.Q.2d 1018 (Fed. Cir. 1993). It is insufficient that the prior art discloses the components of the claims sought to be patented. A teaching, suggestion or incentive to make the combination is required for the combination of the art to demonstrate obviousness. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 U.S.P.Q.2d 1321 (Fed. Cir. 1990).

With regard to the Examiner's rejection of claims 39 and 42 under 35 U.S.C. 103(a) as being unpatentable over Holt, alone or in view of Back, the applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to modify the disclosure of Holt, or to combine it with the disclosure of Back, to arrive at the subject matter of these claims as a whole. Back is directed to systems and methods for providing an interface for navigating dynamic text, a subject matter substantially different from manipulation of color information data. In any case, Back does not fill the gap in the disclosure of Holt, e.g., because it also does not disclose or suggest a conversion from values or figures into text or vice versa, nor does Back provide a motivation to store/communicate data in text format, in the manner disclosed and claimed by applicants (see amended independent claims 21).

Further, a person of ordinary skill in the art would not be motivated to combine Holt and Back, as proposed in the Office Action, because Holt only teaches transmitting color data in the form of values and not text, while Back uses XML format to transmit text only for increasing the reading speed and comprehension, and allowing a user to navigate faster in a reading stream (col. 2, line 30 to col. 3, line 10). Thus, neither Holt nor Back contains any indication that data should be converted from values or figures into text or vice versa. Thus, Applicants respectfully submit that a prima facie case of obviousness has not been established with respect to claims 39 and 42 of the present application, and that dependent claims 39 and 42 are patentable over the art of record for at least the reasons noted above with respect to independent claim 21. Applicants respectfully request that the current rejection of claims 39 and 42 be reconsidered and withdrawn.

In conclusion, after entry of the this paper, applicants respectfully submit that the subject application is now in condition for allowance and an action acknowledging same is respectfully requested. In reviewing this Amendment "A" and Response, should the Examiner have questions or require additional information, the Examiner is cordially invited to call the undersigned attorney, so this case may receive prompt action leading to an early Notice of Allowance. Such action is earnestly solicited.

Respectfully submitted,

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